

REMARKS

Claims 1-15 remain pending, and claims 5 and 15 are currently amended. No claims are canceled or added.

Claims 5 and 15 stand objected to due to form. Although applicants question the authority of the examining corps to issue claim objections in an Examiner's Answer, applicants nonetheless amend both claims 5 and 15 as shown above to expedite prosecution. Withdrawal of the objection is now solicited.

Claims 1, 7, and 13 stand rejected under 35 U.S.C. § 102(b) as anticipated by Setlak et al., U.S. Patent No. 5,940,526. Applicants respectfully traverse this rejection.

Claim 1 describes a fingerprint recognizing apparatus, and claims 7 and 13 describe an electrical unit including a fingerprint recognizing apparatus. Each of these claims specifies that the fingerprint recognizing apparatus or the electrical unit including the fingerprint recognizing apparatus have a "contact section." Claim 1 further specifies that the contact section is "electrically connected to the ground of the apparatus body," and claims 7 and 13 further specify that the contact section is "electrically connected to the ground of the unit casing." Accordingly, to justify the anticipation rejection, the PTO must explain how Setlak et al. supposedly teaches a contact section electrically connected to ground as claimed.

The Examiner's Answer indicates that the element of Setlak et al., which purportedly teaches such contact section, is first conductive strip or external electrode 54. However, Setlak et al. does not teach that electrode 54 is electrically connected to ground, so the new rejection is not justified. Applicants elaborate in the following:

In column 5, in the vicinity of line marker 15, Setlak et al. explains as follows how electrode 54 interacts with other elements shown in Fig. 2:

In the illustrated embodiment, the first external electrode 54 is connected to an excitation drive amplifier 74 which, in turn, drives the finger 79 with a signal may be typically in the range of about 1 KHz to 1 MHz.

It should be clear that, if electrode 54 were connected to ground, excitation drive amplifier 74 could not drive finger 79 with a signal in the range of about 1 KHz to 1 MHz. More specifically, if electrode 54 were connected to ground, the output of excitation drive amplifier 74 would be ground. Obviously, it is not possible to drive a finger with an AC signal by positioning against the finger an electrode connected to ground.

In column 6, in the vicinity of line markers 15 and 20, Setlak et al. explains as follows how electrode 54 interacts with other elements shown in Fig. 4:

The sensor may include power control means for controlling operation of active circuit portions 100 based upon sensing finger contact with the first external electrode 54 as determined by the illustrated finger sense block or circuit 101. For example, the finger sense circuit 101 may operate based upon a change in impedance to an oscillator to thereby determine finger contact. Of course, other approaches for sensing contact with the finger are also contemplated by the invention.

If electrode 54 were connected to ground, as stated in the Examiner's Answer, the signal to finger sense circuit 101 would always be the same, so it could *not* sense finger contact with electrode 54, as Setlak et al. teaches is its function.

Given the explanation above, applicants respectfully submit that Setlak et al. does not teach that this electrode 54 is electrically connected to ground. Accordingly, the rejection is improper.

Applicants acknowledge that the Examiner Answer cites column 6, lines 13-18 & 48-58, to support the contention that electrode 54 is electrically connected to ground. Regarding lines 13-18, applicants explain above why that text does not provide such support. Regarding lines

48-58, which include the recitation “the active portions remain grounded until ...,” nowhere does the cited text state that *electrode 54* is grounded. The Examiner’s Answer does not explain why electrode 54 should be interpreted as one of the “active portions” referenced in this recitation. Note above in line 16 of the same column that the terminology “active portions” is used as “active circuit portions 100,” and Fig. 4 clearly shows that electrode 54 is not part of active circuit portions 100.

The statement in the Examiner’s Answer bridging pages 4 and 5 notes that an operator’s finger contacts both electrode 54 and cover 53’, which is connected to ground through a charge-bleed resistor. It is questioned whether the intent was to state that electrode 54 is interpreted as connected to ground, because it comes in contacts with another element (finger 79) that also contacts a third element (cover 53’), which is connected to ground. If such interpretation of claim terminology were proper, any element of any circuit could be interpreted as connected to ground (unless maybe it was surrounded by a vacuum), which clearly is not proper. Although MPEP § 2111 instructs the PTO to interpret claims broadly, the MPEP requires that the interpretation be reasonable. An interpretation so broad that would permit any element of a circuit to be interpreted as connected to ground is clearly not reasonable.

Applicants of course acknowledge that cover 53’ is shown in Fig. 4 as connected to ground through charge bleed resistor 104. However, one skilled in the art would clearly understand that the basic intent is to bleed charge from an operator’s finger through cover 53’ to ground, and the presence of a charge bleed resistor does not prevent achieving that goal. In contrast, if electrode 54 were connected to ground, even through a charge bleed resistor, the circuitry would not function as intended, as explained above.

If the PTO were to interpret “connected to ground” as not to cover an element connected to ground through an intervening element, such as a charge bleed resistor, then even cover 53’ would not be interpreted as connected to ground. Certainly, such interpretation would not support a holding that electrode 54 were connected to ground.

Given the usage of the term “ground” in Setlak et al. and in applicants’ specification and claims, it must be concluded that it would not be reasonable to interpret electrode 54 as electrically connected to ground.

For at least the reasons provided above, applicants solicit the withdrawal of the anticipation rejection of claims 1, 7, and 13.

Claims 2-5, 8-10, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Setlak et al. in view of Bradney et al., U.S. Patent No. 6,208,264. Applicants respectfully traverse this rejection.

Although not stated specifically, by omission of any statement to the contrary, the Examiner’s Answer implies that the obviousness rejection of claims 2-5, 8-10, 14, and 15 is based in part on electrode 54 of Setlak et al. teaching a contact section electrically connected to ground as claimed. As explained above, however, electrode 54 is not connected to ground. Therefore, the obviousness rejection of claims 2-5, 8-10, 14, and 15 is not justified.

Accordingly, applicants solicit the withdrawal of the obviousness rejection of claims 2-5, 8-10, 14, and 15.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as obvious over Setlak et al. Applicants respectfully traverse this rejection.

Although not stated specifically, by omission of any statement to the contrary, the Examiner’s Answer implies that this obviousness rejection of claim 14 also is based in part on

electrode 54 of Setlak et al. teaching a contact section electrically connected to ground as claimed. As explained above, however, electrode 54 is not connected to ground. Therefore, the obviousness rejection of claim 14 is not justified.

Accordingly, applicants solicit the withdrawal of this obviousness rejection of claim 14.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as obvious over Setlak et al. in view of Gainey, U.S. Patent No. 6,382,416. Applicants respectfully traverse this rejection.

Although not stated specifically, by omission of any statement to the contrary, the Examiner's Answer implies that this obviousness rejection of claims 6 and 12 is based in part on electrode 54 of Setlak et al. teaching a contact section electrically connected to ground as claimed. As explained above, however, electrode 54 is not connected to ground. Therefore, the obviousness rejection of claims 6 and 12 is not justified.

Accordingly, applicants solicit the withdrawal of this obviousness rejection of claims 6 and 12.

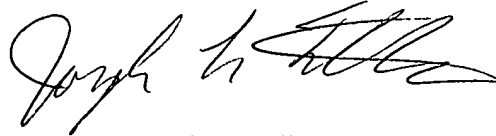
Claim 11 is not rejected in the Examiner's Answer. Although withdrawing the former rejection of claim 11 without issuing a new rejection of that claim may or may not have been intended, the fact remains that claim 11 depends from claims 9 and 10, and, as indicated above, the obviousness rejection of those claims is improper. Therefore, even if the intent was to reject claim 11, also, the rejection would have been improper for at least the reason that claim 11 depends from claims 9 and 10.

In view of the remarks above, applicants now submit that the application is in condition for allowance. Accordingly, a Notice of Allowability is hereby requested. If for any reason it is believed that this application is not now in condition for allowance, the Examiner is welcome to

contact applicants' undersigned attorney at the telephone number indicated below to discuss resolution of the remaining issues.

If this paper is not timely filed, applicants petition for an extension of time. The fee for the extension, and any other fees that may be due, may be debited from Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "Joseph L. Felber", written in a cursive style.

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